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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,661	01/10/2001	Thomas Magid	9726-2	7492

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EXAMINER	
THEIN, MARIA TERESA T	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,661	MAGID, THOMAS	
	Examiner	Art Unit	
	Marissa Thein	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-13 and 15-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-13 and 15-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2005 has been entered.

Response to Amendment

Applicant's "Amendment" filed on September 2, 2005 has been considered with the following effect.

Applicant's response to claim 1 has overcome the Examiner's rejection of such claim under USC § 101.

Claims 1-2, 6, 8-11, 18, 20, 22, 26-29, 31 and 34 are amended. Claims 1-4, 6-13, and 15-34 are pending in this application.

Claim Objections

Claims 1-4, 6-13, and 15-34 are objected to because of the following informalities:

"Claim 1" should be --1--;

"Claim 2" should be --2--;

"Claim 3" should be --3-- ;

and so on.

Appropriate correction is required.

Claims 1-4, 6-9, 21-22, 26-27, 31, 34 are objected to because claim 1 recites a system and a computer readable medium comprising a program. Applicant can only recite one statutory criterion either a system claim or a computer readable storage medium claim. If Applicant decides to claim a system, the claim should recite "a system comprising: a computer.....; a database....., so on". If Applicant decides to claim a computer readable medium comprising a program, the claim should recite "a computer readable medium comprising a program instructed for...., the medium comprising: a machine readable code for permitting .....", so on.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-12, 15-30, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,933,498 to Schneck et al.

Regarding claims 1, 10, and 19, Schneck discloses a computerized system, method and computer program product comprising:

- a computerized central network core site comprising at least one computer readable storage medium and a program therein for interesting and retaining at least one qualified purchaser or licensee of a patent or trade secret, the

program having machine readable code for permitting the purchaser to attain access to varying levels of information disclosure relating to the patent or trade secret in the computer readable storage medium based on levels of interest and the machine readable code protecting the levels of information disclosure, where the system comprising: (col. 6, lines 51-58; col. 7, lines 1-7; col. 7, lines 27-29; col. 10, lines 20-26; col. 15, lines 1-8; col. 15, lines 44-50; col. 22, lines 55-58; col. 29, lines 34-36; col. 34, lines 37-39);

- a seller (data distributor) presenting a first level of information disclosure of the patent or trade secret relating to a product or method (col. 1, lines 32-35) to a prospective purchaser via system and requesting a first response, the first response comprising a fulfillment a fulfillment of a first demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48):
- the purchaser fulfilling the first demand via the system (see at least col. 22, liens 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- the seller presenting a second level of disclosure that is more confidential and more secure than the first level of disclosures relating to said product or method that is more confidential and is more secure than the first level of disclosure to the purchaser and requests a second response, the second response comprising a fulfillment of a second demand by the purchaser (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 34, lines 43-48)

- the purchaser fulfilling the second demand (see at least col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59);
- and wherein at least one level of information disclosure comprises an amount of description of said product or method (col. 6, lines 51-58; col. 13, lines 7-9) and the seller and purchaser optionally entering into a contract (see at least col. 22, lines 5-61)

Regarding claims 2, 6, 8-9, 11, 15, 17-18, 20, and 22, 24, Schneck discloses seller presents additional levels of disclosure and the seller requesting additional responses; the successive level of information disclosure presenting has associated therewith and increasing level of confidentiality and security; and wherein each level of the disclosure comprises revealing additional information relating to the patent or trade secret; accessing peripheral services by the purchaser or seller relating to the marketing or exchange of patents or trade secrets offered (see at least col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42; col. 34, lines 37-39).

Regarding claims 3 and 12, Schneck discloses the contract is a licensing agreement (col. 29, lines 34-40).

Regarding claims 7 and 16, Schneck discloses the demands comprise compensation, comprising one or more of money, certification authentication or agreements (col. 22, lines 5-12; col. 22, lines 21-46).

Regarding claims 21, 23, 25-30, and 32-33, Schneck discloses the first and second responses are requested by the purchaser and comprise fulfillment of a first and

second demand by the seller, and the seller fulfills the first and second demands; the purchaser also requests a response from the seller comprising fulfillment of a demand by the seller prior to presentation of each level of disclosure; first level of disclosure is unsecure; one or more additional steps of presenting levels of disclosure and requesting responses by the seller and purchaser and fulfilling the responses (see at least col. 9, lines 55-59; col. 16, lines 39-42; col. 20, lines 9-37; col. 22, lines 55-61; col. 23, lines 6-60; col. 33, lines 50-59; col. 22, lines 5-42).

Regarding claim 34, Schneck discloses Internet (col. 15, lines 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 13, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,933,498 to Schneck et al in view of U.S. Patent No. 5,991876 to Johnson et al.

Regarding claims 4 and 13, Schneck substantially discloses the claimed invention, however, it does not explicitly disclose the contract is an assignment of rights. Schneck discloses the purchase of a license, such as intellectual property (col. 10, lines 27-28; col. 29, lines 34-35). The intellectual property can be trade secret col. 34, lines 37-39).;

Johnson, on the other hand, teaches the contract is an assignment of rights (Figure 3; col. 11, lines 4-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Schneck, to include the contract is an assignment of rights, as taught by Johnson, in order to manage rights to authorized users (Johnson, col. 1, line 7).

Regarding claim 31, Schneck substantially discloses the claimed invention, however, it does not explicitly disclose the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times. Schneck discloses the purchase of a license, such as intellectual property (col. 10, lines 27-28; col. 29, lines 34-35). The intellectual property can be trade secret col. 34, lines 37-39).

Johnson, on the other hand, teaches the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times (col. 2, lines 4-21; col. 3, lines 7-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Schneck, to include the contract permits the purchaser to make multiple copies to the tangible item or perform the method multiple times, as taught by Johnson, in order to manage rights to authorized users (Johnson, col. 1, line 7).

Response to Arguments

Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive.

Applicant's remark that "Schneck does not anticipate the claims under 35 USC 102 (b) because the data in Schneck is not information relating to patent or trade secret".

The Examiner notes that Schneck discloses the information relating to patent or trade secret. Schneck discloses the data are typically intellectual property (col. 10, lines 27-28). Furthermore, Schneck discloses "the protection offered by the present invention may be used to enforce rights in intellectual property whether the protection at law is categorize as.... **trade secret....."** (col. 34, lines 37-39).

Applicant's remark that "Schneck is directed to a system for the protection of a digital data music product, ...thus does not anticipate the present claims because Schneck does not relate to information disclosure of patents or trade secrets relating to a product or method, as is required by the present claims".

The Examiner draws Applicant's attention to the discussion above.

Applicant's remark that "Schneck does not apply to information relating to patents or trade secrets".

Again, the Examiner draws Applicant's attention to the discussion above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot
November 14, 2005

STEVE B. MCALLISTER
PRIMARY EXAMINER